REMARKS

On March 3, 2004 the undersigned filed under Rule 1.8(a) a response to a non-final office action mailed September 9, 2003. This response was received in the PTO on September 5, 2003. The response included a petition for a 3-month extension of time, and was therefore timely.

Unfortunately, owing to a clerical error within the offices of the undersigned attorney, the response filed contained a copy of a previous response, and not the response to the examiner's current rejections. A copy of the correct text of the response is filed herewith.

Because the responses filed on June 17, 2003 and March 3, 2004 were identical, it must have been immediately obvious to the examiner that a clerical error had occurred, and that the response filed on March 3, 2004 "is *bona fide* but contains a serious omission" within the terms of MPEP § 714.03.

> In that situation, the MPEP states that the examiner should
> A) if there is sufficient time remaining for applicant's reply to be filed within the time period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)), notify applicant that the omission must be supplied within the time period for reply; or
> B) if there is insufficient time remaining, issue an Office action setting a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c).

This was not done. Instead, the examiner issued a notification pursuant to step A) above, notwithstanding that the time period for reply, with all available extensions, had already expired. Effectively, the examiner has issued an office action requiring a response one month BEFORE the office action was mailed.

It is respectfully submitted that this is neither proper nor reasonable.

Withdrawal of the office action mailed on April 9, 2004, the issuance of a proper action under 37 CFR § 1.135(c) setting a time limit expiring no earlier than the effective date of filing of the present response, and the consequent entry of the enclosed corrected response to the office action dated September 9, 2003 are respectfully requested.

Respectfully submitted

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BY: 

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PATENT

Attorney Docket No.: 144-198 (145708)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	Patent application of Michel Riera	:	
		:	Group Art Unit:
Serial No.:	09/242,191	:	1711
Confirmation No.:	9738	:	
Filed:	May 17, 1999	:	Examiner: Thao T. Tran
For:	Device for Generating Magnetic Fields for Catalyzing Physicochemical Reactions	:	

RESPONSE TO NON-FINAL OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the non-final office action, paper no. 25, mailed September 9, 2003. This response is being filed within the third month after the end of the three-month shortened statutory period set in the office action. A separate petition and fee for a three-month extension of time, which extends the due date for response to March 9, 2004, is filed herewith. No other fee is believed to be due in connection with this response. Please charge any other fee that is due in connection with this response, and credit any overpayment, to deposit account no. 50-0573.

CERTIFICATE OF MAILING
UNDER 37 C.F.R. 1.8(a)

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

BY Katrina S'Oliveira

DATE: April 14 2004

REMARKS

General:

Claims 19-37 are pending in the application. Claims 19-37 stand rejected.

35 U.S.C. § 103 rejections:

Claims 19-37 are rejected as obvious over U.S. Patent No. 6,489,872 (Fukushima). It is respectfully pointed out that Fukushima is not prior art against the present application. Fukushima has a filing date of May 6, 1999. The present application is a national phase of a PCT application with an international filing date of August 13, 1997, and a foreign priority date of August 13, 1996. The international filing date of August 13, **1997** necessarily constitutes a date of invention for the purposes of 35 U.S.C. §102(a) and (e) and, by virtue of 35 USC § 363, a date of filing for the purposes of 35 U.S.C. §102(b).[1] That date is clearly earlier than Fukushima's filing date of May 6, **1999**, which is the earliest date at which Fukushima is available as a reference. In addition, applicant believes that the present claims are properly supported by his foreign priority application, which establishes a date of invention by constructive reduction to practice no later than August 13, **1996**.

In addition, it is respectfully pointed out that the examiner has combined features of the invention taught by Fukushima with features of the prior art acknowledged by Fukushima, without identifying any suggestion or motivation for the combination. An invention and its prior art do not form a single teaching, indeed, the disclosure of an invention by its very nature teaches away from the prior art, so the examiner's combination does not establish a *prima facie* case of obviousness.

Let it be assumed *arguendo* that a publication of a nuclear magnetic resonance instrument before August 1996 can be shown: the applicant now believes that the relevant features of Fukushima's device were developed by Bloch in the late 1940's. This device consists essentially of a strong constant magnet (corresponding to the permanent magnet of Fukushima), having within its field a generating coil (corresponding to the "oscillating magnetic field" of Fukushima) and a detecting coil, with axes orthogonal to each other and

[1] Under the applicable former text of 35 U.S.C. §102(e), the present application's U.S. filing date of May 17, 1999 is significant only as the effective date of a patent granted on the present application *as a reference* under 35 U.S.C. §102(e). Thus, the present case cannot, as the law now stands, become a §102(e) reference against Fukushima, but that does not matter because it is already a §102(b) reference against Fukushima.

to the field of the constant magnet. The purpose of the excitation field is to produce quantum shifts in the magnetic moments of the atomic nuclei, which are precessing within the strong constant field. For this purpose, an excitation field of low strength but extremely high frequency (sometimes in the gigahertz range) is used. Because this is an observational technique, it is desirable for the magnetic fields not to produce any lasting change in the materials being studied (which may be living human tissue), because such changes could both interfere with the observations and harm the subject. Because the excitation field is of low strength, it imposes only a very slight variation on the constant background field.

The present application, on the contrary, is directed to a method of producing stereochemical deformations in the molecules of a medium, by generating as high a gradient as possible of the vector product v^H of the displacement velocity of the magnetic field by its amplitude. For this purpose, an NMR device with a very large disparity between the strengths of the constant field and the excitation field is manifestly unsuitable. Further, although specific frequencies of the oscillating field are not discussed, it is inherent in the stated function of the method of the present invention that the frequencies must not be high compared with the relaxation time for the required deformations, and the depiction in the drawings of coils with a large number of turns, and thus a large self-inductance, confirms that NMR frequencies are not used.

Thus, although the NMR devices may be seen as generating a varying magnetic field, they do not disclose or suggest a method of creating stereochemical deformations, or of producing a magnetic field capable of creating such deformations, as claimed in the present application. The examiner argues that this could have been achieved "by optimization through routine experimentation, depending upon user's preference and intended use." However, it can only be obvious to optimize for a use that is itself known or obvious. There is nothing in the prior art of NMR devices to suggest even the possibility of a method of creating stereochemical deformations in accordance with the present invention, so such optimization could not have been obvious except in hindsight based on knowledge of the present invention.

For all of the above reasons, it is believed that claims 19 and 32, and claims 20-31 and 33-37 which are dependent therefrom, are not obvious over the cited prior art.

Conclusion:

In view of the foregoing, reconsideration of the examiner's rejections and allowance of claims 19-37 are earnestly solicited.

Respectfully submitted

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